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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,665	10/05/2005	Sant Muke	5141-00001	7633
26753	7590	03/19/2009		
ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202			EXAMINER JOY, DAVID J	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 03/19/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/530,665

**Applicant(s)**

MUKE ET AL.

**Examiner**

David J. Joy

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 December 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 9, 10, 14, 17, 20-22 and 36-38 is/are pending in the application.  
4a) Of the above claim(s) 5, 17, 20-22 and 36-38 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-4, 9, 10 and 14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 06 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 04/06/2005: 01/21/2008  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of the invention of Group I, Claims 1-4, 9-10, 14 and 17, in the reply filed on December 24, 2008 is acknowledged. The traversal is on the ground that all the claims are directed towards blind embossing through a substantially transparent or translucent layer, that form a single, general, inventive concept. This is not found persuasive. Firstly, it is noted that as set forth in MPEP § 1850 II, if it can be established that the technical feature of the claims is known, there is lack of unity *a posteriori*, since the technical feature (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art. Given that Examiner established that the common technical feature of the present claims is known in the prior art (see ¶ 2 of the Office Action mailed on November 26, 2008), Examiner's position remains that the restriction requirement is proper. Apparently, Applicant believes that the respective subject matter of Groups I, II and III is not patentably distinct over each other. If Applicant clearly states on the record that the subject matter of Groups I, II and III is not patentably distinguishable over each other (e.g., a reference teaching the subject matter of Group I also anticipates, or renders unpatentable, the

subject matter of Groups II and III), the lack of unity requirement will be withdrawn.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 5, 20-22 and 36-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed on December 24, 2008.

3. It is noted that Claim 17 has been withdrawn from consideration as being directed to a non-elected invention, given that the claim is drawn to an article, which is the invention of non-elected Group III. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant's attention is drawn to the fact that Claim 17 was previously directed to a process, but in the latest submission the claim has been modified to recite an article, without properly denoting the amended and cancelled claim language therein.

Furthermore, nonelected Claim 17 depends upon cancelled Claim 16.

#### ***Information Disclosure Statement***

4. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:

US 6,294,241	09/2001	Kaule et al.
US 6,283,509	09/2001	Braun et al.
US 6,183,018	02/2001	Braun et al.
US 5,915,731	06/1999	Jackson
US 5,437,897	08/1995	Tanaka et al.
US 4,715,623	12/1987	Roule et al.
US 4,420,515	12/1983	Amon et al.
US 4,250,217	02/1981	Greenaway
US 1,996,539	04/1935	Dufay
WO 2002/004234	01/2002	De La Rue Int. Ltd.

With respect to the aforementioned documents, all of which were cited as X-references on the International Search Report for international application number PCT/AU03/01316, the references provided information of limited detail and applicability to the present claims, and any citations to those references would merely be cumulative of the rejections that follow.

### *Specification*

5. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet *within the range of 50 to 150 words*. It is important that the abstract **not exceed 150 words** in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract

should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

7. Claims 2-5, 9, 10 and 14 are objected to because of the following informalities:

a. Claims 2-5, 9, 10 and 14 all recite, in Line 1 of each claim, "A method" whereas they should recite "The method" since each claim depends upon Claim 1, which recites "A method" in its preamble. There needs to be proper antecedent basis for each of the dependent claims.

b. Claim 9 recites "the substantially transparent or translucent layer comprises transparent polymeric substrate", whereas it seems that the claim should recite "comprises *a* transparent polymeric substrate" in order to correspond with the provisions of the specification (emphasis added; see Page 6); and

- c. Claim 10 recites "A Method according to claim 1 wherein ...", with the word "method" improperly capitalized.

Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-4, 9, 10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 1, 2, 9 and 10 are indefinite due to the recitation of the limitation that the sheet includes "a substantially transparent or translucent layer". The term "substantially" in these claims is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim (i.e., one cannot discern how transparent the layer must be in order to be substantially transparent), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

11. Claims 1 is also indefinite due to the recitation of the limitation "the transparent or translucent layer" in Line 4 of the claim. There is insufficient antecedent basis for this limitation in the claim, since the layer was previously described as being "a *substantially* transparent or translucent layer" in Lines 2 and 3 of the claim.

12. In addition, Claim 2 is indefinite due to the recitation of the limitation "the substantially transparent or translucent *layers*" in Line 2 of the claim (emphasis added). There is insufficient antecedent basis for this limitation in the claim.

13. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the



claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, Claim 14 recites the broad limitation of "a highly reflective metallic ink", and the claim goes further in also reciting "a silver or gold metallic ink" which is the narrower statement of the limitation.

14. Claim 14 is indefinite due to the recitation of the limitation that the "reflective ink, [comprises] a *highly* reflective metallic ink". The term "highly" in the claim is a relative term which renders the claim indefinite. The term "highly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

15. Claim 17, which is recited as being dependent upon the "security device according to claim 16" is indefinite due to the fact that it depends upon a cancelled claim.

16. Claims 3, 4, and 14 are rejected accordingly, as they all depend upon Claim 1.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claims 1-4, 9, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent Application Publication of Hardwick et al. (2002/0027361; hereinafter "Hardwick") in view of the U.S. Patent of Shenton (5,199,744).

20. Hardwick teaches a method of forming a security device that includes providing a sheet that includes a transparent or translucent layer ("clear plastic sheet") and a

reflective layer ("security device"), which is applied to one side of the sheet, and which is visible through the sheet (see Abstract; see also Figures 1 and 6; see also ¶¶ [0011]-[0013], [0017], [0018], [0022] and [0034]). Hardwick also provides the clear plastic sheet is formed from a transparent polymeric sheet, which can comprise a single layer film or a laminate of two or more layers of transparent polymeric film, which could be treated as a coating applied to a substrate (see ¶ [0035]). In addition, Hardwick teaches that the sheet is embossed in the portion that is visible through the sheet, thereby forming a security device such as an image that creates optical effects or is otherwise optically variable (see ¶¶ [0022] and [0037]). While Hardwick expressly provides that the security device can be embossed, it fails to teach or suggest that the security device is blind embossed. However, Shenton, which is drawn to a security device, recites that blind embossing is known in the art, as a way to confer a surface profile to the substrate of a security device without having to have any ink applied thereto (see Column 1, Lines 34-37). As both Hardwick and Shenton are drawn to the same field of invention, it would have been obvious to a person having ordinary skill in the art, at the time of invention, to have made the security device according to the method taught by Hardwick, but to incorporate a blind embossing technique, given the teachings of Shenton.

21. Hardwick teaches that the sheet is only partly opacified on one surface of the sheet, thereby forming a half-window through which the security device may be inspected (see Abstract; see also Figures 1 and 6; see also ¶¶ [0014]-[0017], [0019], [0049] and [0050]). Hardwick also teaches that the steps of applying the security device, and opacifying the sheet may be performed in different orders (see ¶ [0019]). In addition, Hardwick recites that the security device may be applied to the surface of the sheet, or the security device may be embedded within the sheet (see ¶ [0018]). Further, Hardwick provides that the sheet comprises a coating (i.e., of the opacifying ink) that is applied to the substrate (see ¶¶ [0014]-[0016] and [0033]-[0036]). Also, Hardwick teaches that the reflective layer (i.e., the security device) is formed by printing with ink that contains a reflective, nacreous, or pearlescent pigment (see ¶¶ [0022] and [0037]).

### *Conclusion*

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 2002/0030360  
AU-B-87655/82

03/2002  
08/1982

Herrmann et al.  
Commonwealth Sci. and Ind.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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/DJJ/  
Examiner, Art Unit 1794  
03/10/2009

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794